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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/712,245 | 11/12/2003 | Shih-Shien Hsiao | JCLA12023 | 9471 |
| 7590 | 05/30/2006 | | EXAMINER | |
| J.C. Patents, Inc. Suite 250 4 Venture Irvine, CA 92618 | | | | NGUYEN, DUC M |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2618 | |

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/712,245 | HSIAO, SHIH-SHIEN |
| | Examiner | Art Unit |
| | Duc M. Nguyen | 2618 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 April 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This action is in response to applicant's response filed on 4/26/06. Claims 1-11 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-3, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable by **Kubo et al (US 6,795,715)** in view of **Yuyama et al (US 5,612,732)**.

Regarding claim 1, **Kubo** discloses a mobile phone device with video output function for transmitting an image data to an external device via a cable (see col. 3, lines 44-49, wherein it is clear that a cable is implicitly needed for connecting to a VTR or TV set), comprising a mobile phone circuit with digital camera function, for capturing a digital image and a video converter, coupled to the mobile phone circuit for converting the digital image into an analogue video output signal (see Figs 1-2 and col. 6, lines 17-26), which would include all the claimed limitations except for a digital/analog converter (DAC). Here, although **Kubo** is silent on the DAC for the video converter circuit 12, it is noted that in order to convert image data to a TV or video signal, a DAC would obviously, if not implicitly, be needed by the video converter circuit

12 in Kubo, in order to provide a video signal output as disclosed by **Yuyama** (see Fig. 3 and col. 8, lines 15-18). Therefore, the claimed limitation regarding a DAC is made obviously by Kubo and Yuyama.

Regarding claim 2, it is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that Kudo would disclose an RF unit, a digital camera, a display and a base frequency processor as claimed. However, **Kubo** fails to disclose a memory card. However, **Yuyama** discloses a memory card for storing images taken by the camera (see Fig. 24 and col. 30, lines 1-10). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to further incorporate the above teaching of Yuyama to Kudo for utilizing a memory card as well, for extending the storage capability of camera and the mobile phone.

Regarding claim 3, it is rejected for the same reason as set forth in claim 1 above. In addition Kudo discloses a LCD display (see col. 5, lines 13-14).

Regarding claims 9-11, they are rejected for the same reason as set forth in claim 1 above. In addition, since Kudo discloses a video output terminal 10 (see Fig. 1), it is clear that the output terminal signal in Kudo can be displayed through a display device with a video input terminal as claimed (i.e, VCR, screen projector, TV set, etc).

3. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable by **Kubo** in view of **Yuyama** and further in view of **Lee** (US 2004/0230789).

Regarding claims 4-8, they are rejected for the same reason as set forth in claim 2 above. In addition, since such memory cards as recited in the claims are well known

in the art as mentioned by Lee (see [004]), it would have been obvious to one skilled in the art at the time the invention was made to modify Yuyama and Kudo for utilizing such memory cards as well, for utilizing advantages provided by each type of the card such as cost, speed, storage capacity, compact, or multimedia features, etc.

Response to Arguments

4. Applicant's arguments filed 4/26/06 have been fully considered but they are not persuasive.

In response to applicant's argument that Yuyama is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Yuyama is not nonanalogous art because it directs to a portable phone with integrated camera feature. Further, at the time the invention was made, the use of a mobile phone with integrated camera feature is well known in the art, one skilled in the art would recognize the benefit of wireless feature for modifying Yuyama by replacing the portable phone in Yuyama with a mobile phone as well, for eliminating the need of a cable connection.

In addition, just for the sake of the argument, assumed that Yuyama is non-analogous art, its teaching regarding a digital-to-analog converter for producing analog video signal is also in the field of applicant's endeavor, and also be reasonably pertinent

Art Unit: 2618

to the particular problem with which the applicant was concerned. Therefore, the combination of Kubo and Yuyama regarding a digital-to-analog converter is proper. Further, as mentioned the rejection above, it is believed that the digital-to-analog converter is obviously, if not implicitly, disclosed by Kubo in col. col. 3, lines 44-49, in order to convert the image data from the digital camera to the analog video signal for displaying on a TV set.

As to claims 4-8 regarding Lee reference on memory cards. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since utilizing different types of memory cards as recited in the claims (i.e, SD, MMS, XD) are well known in the art as mentioned by Lee (see [004]), it would have been obvious to one skilled in the art at the time the invention was made to incorporate Lee's teaching to memory cards in Yuyama and Kudo as well, for utilizing advantages provided by each type of the card such as cost, speed, storage capacity, compact, or multimedia features, etc, that would be suitable to the need of a user/customer. Here, the motivation for using different types of memory cards as claimed is to use a type of memory card that would be suitable to the need of a user/customer.

Art Unit: 2618

For foregoing reasons, the examiner believes that the pending claims (1-11) which rely on the patentability of a digital-to-analog converter or a type of memory card are not allowable over the cited prior art.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. **Any response to this final action should be mailed to:**

Box A.F.

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

Art Unit: 2618

(571) 273-8300 (for **formal** communications intended for entry)

(571)-273-7893 (for informal or **draft** communications).

Hand-delivered responses should be brought to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Any inquiry concerning this communication or communications from the examiner
should be directed to Duc M. Nguyen whose telephone number is (571) 272-7893,
Monday-Thursday (9:00 AM - 5:00 PM).

Or to Doris To (Supervisor) whose telephone number is (571) 272-7629.

Duc M. Nguyen, P.E.

May 22, 2006

A handwritten signature in black ink, appearing to read "Duc M. Nguyen".